

EXHIBIT D

Amendment A (13 pages)



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4/20/93

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 07/736,071
Group Art Unit: 2311
Examiner: Gail O. Hayes
Inventor: Peter J. Kight et al.
Filed: July 25, 1991
For: APPARATUS FOR AND METHOD OF
BILL PAYMENT

AMENDMENT

RECEIVED
APR 21 1993
GROUP 2300

The Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

The following Amendments and Remarks are in response to the
Examiner's First Office Action mailed on November 4, 1992.

IN THE SPECIFICATION:

Please amend the title of the invention as follows:

[Apparatus for and Method of] COMPUTERIZED BILL PAYMENT
SYSTEM AND METHOD

I hereby certify that this correspondence is being
deposited with the United States Postal Service as first class
mail in an envelope addressed to: Commissioner of Patents and
Trademarks, Washington, D.C. 20231 on April 2, 1993.
By: [Signature], Attorney for Applicant

Please amend the specification as follows:

On page 1, line 15, delete ",".

On page 2, line 4, change "i.e." to --i.e.,--.

On page 2, line 5, after "loan", add --association--.

On page 2, line 12, delete "only".

On page 2, line 13, after "service", add --only--.

On page 3, line 2, after "and", add --the--.

On page 3, line 5, delete ",".

On page 3, line 14, change "push button" to --push-button--.

On page 4, line ²¹~~19~~, after "to", add --be--.

On page 4, line ²³~~21~~, after "telephone", add --number--.

On page 5, line 11, change "consumers' bills by" to --a consumer's bill by a--.

On page 5, line 15, change "once" to --after--.

On page 5, line 20, change "institution's" to --institutions--.

On page 6, line 18, change "amounts" to --amount--.

On page 6, line 24, change "merchants" to --merchant's--.

On page 7, line 7, change "as," to --as--.

On page 7, line 14, change "as," to --as--.

On page 7, line 25, delete ",".

On page 8, line 4, change "On a personal computer, a" to --A--.

On page 8, line ²¹~~21~~, change "February -" to --February being--.

On page 10, line 16, change "ACH" to --Automated Clearing House (ACH)--.

On page 10, line 22, change "check" to --checks--.

On page 10, line 23, change "check" to --checks--.

On page 11, line 10, change "may be initiated 56" to --56
may be initiated--.

On page 11, line 11, after "day", add --,--.

on page 12, line 4, delete "automated clearing house;" and
adjust the spacing so that the left parenthesis immediately
precedes "service".

On page 12, line 8, delete ",".

On page 12, line 24, change "i.e. -" to --i.e., --.

On page 13, line 5, change "Federal Law" to --federal law--.

On page 13, line 8, after "by", add --a--.

On page 13, line 27, change "check" to --credit--.

On page 13, line 22, change "electronic" to --an electronic
payment--.

On page 14, line 4, change "check" to --credit--.

On page 14, line 15, after "78", add --being--.

On page 14, line 16, change ", such as," to --such as--.

On page 14, line 18, change ", such as," to --such as--.

On page 14, line 24, change "they are" to --the payment
date is". Also on line 24, change "on" to --from--.

On page 15, line 7, change "Fegures" to --Figures--.

On page 15, line 20, delete ",".

On page 16, line 21, delete ",".

On page 16, line 23, delete ",".

On page 17, line 22, after "example", delete ",".

IN THE CLAIMS:

Please cancel claims 17 and 23.

Please amend the claims as follows:

1. (Amended) A computer system for enabling a service provider to pay a consumer's bills at the consumer's instruction, said system comprising:

means for inputting into said computer system a consumer's information [into said computer system] relating to the consumer's financial institution(s) and billing entities to be paid;

means for storing said information;

means for defining and storing mathematical interrelationships relating to said information;

a) means for the consumer to electronically access said system from a remote location and instruct said [service provider] system to pay said consumer's bills regardless of whether a relationship exists between the consumer's financial institution(s) and said system; and

means for enabling said service provider to make payment to said billing entities regardless of whether a relationship exists between any of said business entities and said system.

2. (Amended) The system of [C]claim 1, wherein the means for storing includes a financial institutions file database[,] stored on memory means in association with said computer.

3. (Amended) The system of [C]claim 1, wherein the means for storing includes a merchant master file database[,] stored on memory means in association with said computer.

4. (Amended) The system of [C]claim 1, wherein the means for making payment includes electronic funds transfer.

5. (Amended) The system of [C]claim 1, wherein the means for making payment includes drafts encoded with micr codes.

6. (Amended) The system of [C]claim 1, wherein the means for making payment includes checks written on said service provider's account.

7. (Amended) The system of [C]claim 1, wherein the means for said consumer to access said system is a touch tone telephone.

8. (Amended) The system of [C]claim 1, wherein the means for said consumer to access said system is a computer terminal.

9. (Amended) A method of operating a service provider's computer system to pay bills for consumers regardless of where the consumers bank or what bills are to be paid, said method comprising the steps of:

inputting first data relating to consumers' financial institutions into said computer system;

inputting second data relating to consumers' billing entities to be paid into said system;

storing said first data and said second data in said system;

establishing limits within said system regarding the credit said service provider is willing to extend to said consumers;

defining and storing mathematical interrelationships relating to said first data, said second data and said credit limits;

instructing said system via consumer initiated instructions from remote electronic means to pay particular billing entities;

[analyzing financial risks to the service provider in paying consumers' bills to determine] determining the preferred form of each payment based on said mathematical interrelationships; and

arranging payment through the service provider to said billing entities [through] by said preferred form of payment[, of an amount instructed by said consumers] in accordance with said payment instructions.

10. (Amended) The method of [C]claim 9, wherein said first data includes the financial institutions routing transit numbers and consumers' account numbers.

11. (Amended) The method of [C]claim 9, wherein said second data includes billing entities' names[,] and addresses, and consumers' merchant account number(s).

12. (Amended) The method of [C]claim 9, wherein said arranging payments to billing entities as [specified] instructed by said consumers[,] is accomplished with a micro encoded draft prepared by said computer system.

13. (Amended) The method of [C]claim 9, wherein said arranging payment to billing entities as [specified] instructed by said consumers[,] is accomplished with electronic fund transfer.

14. (Amended) The method of [C]claim 9, wherein said arranging payment to billing entities as [specified] instructed by said consumers[,] is accomplished with a check written on said service provider's account.

15. (Amended) The method of [C]claim 9, wherein said instructing said system to pay is accomplished by a push-button telephone whereby the consumer responds to a voice unit within said system.

16. (Amended) The method of [C]claim 9, wherein said instructing said system to pay is accomplished via a computer terminal whereby the consumer selects billing entities and billing amounts to be paid.

18. (Amended) A process for enabling a service provider to make payments on a consumer's account at the consumer's instruction, said process comprising:

inputting said consumer's banking and merchant information into a database;

storing said information in said database;

providing means for said consumer to request said service provider via a telecommunications device to pay a merchant a particular amount;

instructing a computer system to analyze said consumer's payment request with regard to said stored information and predetermined parameters established for said service provider;

[analyzing said consumer's payment request to determine the preferred form of payment; and]

[paying said merchant by means selected] instructing a computer system to select payment means from a member of a group consisting of a micr encoded draft, a check, a charge to a credit card, and electronic funds transfer[, said member of the group selected by said computer system analysis] based on

[predetermined parameters established for said service provider] said computer analysis; and

paying said merchant by said selected payment means.

19. (Amended) A system for use by a service provider to pay consumers' bills, said system comprising:

a financial institutions database having specific information pertaining to the consumers' financial institutions;

a billing entities database having specific information pertaining to the billing entities to be paid;

at least one remote telecommunications device to be in communication with a computer operated by said service provider;

a program to be used with said computer to analyze instructions received from said consumers through said telecommunication devices, said analysis including determination of a preferred form of payment to said billing entities; and

means for effecting payment to said billing entities independent of whether the service provider is a bank.

20. (Amended) The system of claim 19, wherein said telecommunications device is a touch tone telephone in contact with a voice response unit.

21. (Amended) The system of claim 19, wherein said telecommunications device is a personal computer in communication with a front end processor.

22. (Amended) The system of claim 19, wherein said program analysis includes a determination of a consumer's [credit worthiness] creditworthiness.

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24. (Amended) The system of claim [23] 19, wherein the preferred form of payment is selected from a member of the group consisting of electronic funds transfer, a charge to a credit card, a check, and a draft.

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25. (Amended) The system of claim 19, wherein said means for effecting payment includes a printer and troy post processor.

26. (Amended) The system of claim 19, wherein said program differentiates between fixed and variable merchants.

27. (Amended) The system of claim 19, wherein said program includes a processing calendar for determining dates on which to pay particular billing entities.

28. (Amended) The system of claim 19, wherein said [program] determination of a preferred form of payment includes certain dollar amount edits[to determine the form of payment to said billing entities].

IN THE ABSTRACT:

Please amend the abstract as follows:

On line 9, delete "based on a financial".

On line 10, delete "risk analysis".

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On line 11, after "instructions", add ~~-~~based on a financial risk analysis--.

REMARKS

The Examiner has objected to the title of the invention, stating that the title does not clearly indicate the invention

to which the claims are directed. The Examiner also has stated that the applicants have not given a post office address anywhere in the application papers as required by 37 C.F.R. §1.33(a).

The Examiner has rejected claims 1-22 and 26 under 35 U.S.C. §103 as being obvious over Shavit or Pronto. The Examiner has rejected claim 27 under 35 U.S.C. §103 as being obvious over Shavit or Pronto, and further in view of MYTE MIKE. Applicants respectfully traverse the Examiner's rejections of the above claims. The Examiner has objected to claims 23-24 and 28, stating that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants have amended the title to more clearly indicate the invention to which the claims are directed. As to the Examiner's statement that the applicants have not provided a post office address in their application papers as required by 37 C.F.R. §1.33(a), applicants note that all of their addresses are included on either the Declaration submitted with application on July 5, 1991 or the Declaration submitted in response to the Notice to File Missing Parts of Application on September 5, 1991. Copies of these Declarations are attached.

In response to the Examiner's objections to claims 23-24 and 28, applicants have canceled claim 23, amended claim 19 to incorporate the limitation of claim 23, and amended claim 24 to depend on claim 19 rather than claim 23. These claims should now be in condition for allowance.

Applicants respectfully submit that their invention as presented in amended claim 1 distinguishes over and is unobvious in view of either Shavit or the Pronto system. Shavit discloses a system that enables a service provider to process business transactions between system users. (Col. 1, lines 8-9). The system of Shavit requires that each party to a transaction processed by the system have a relationship to the system, i.e., the system can process a payment transaction only when both the payor and the payee are users of the system. By contrast, the claimed invention provides means for enabling a service provider to make payment to billing entities even when no relationship exists between the business entities to be paid and the bill-paying system. The claimed invention provides means for making payment to the payee when only the payor is a user of the system. As stated in the specification at the bottom of page 2 and described in detail thereafter, the present invention is a universal bill payment system that works regardless of the financial institution and the bill to be paid.

The Pronto system requires the existence of a relationship between the payor's financial institution and the bill-paying system: a consumer may use the Pronto system only if her financial institution is affiliated with the Pronto system. The claimed invention provides means for a consumer to instruct the service provider to pay the consumer's bills regardless of whether the consumer's financial institution has any relationship or affiliation with the system.

Applicants respectfully submit that their invention as presented in amended claim 9 also distinguishes over and is unobvious in view of either Shavit or the Pronto system. The claimed invention as presented in amended claim 9 provides a method for operating a service provider's computer system that includes the step of determining a preferred form of payment based on mathematical interrelationships relating to consumers' data and limits on the credit the service provider is willing to extend to respective consumers. In the claimed invention, the step of determining a preferred form of payment is performed directly by the computer system, not by the service provider. Applicants respectfully submit that neither Shavit nor the Pronto system teaches or discloses a method of operating a computer system that includes such a step performed by the computer system. In addition, applicants find nothing in either Shavit or the Pronto system regarding establishing limits on the credit the service provider is willing to extend to respective consumers.

Applicants further submit that their invention, as presented in amended claim 18, distinguishes over and is unobvious in view of either Shavit or the Pronto system. The claimed invention as presented in amended claim 18 provides a process for enabling a service provider to make payments on a consumer's account that includes instructing a computer system to select particular electronic or non-electronic payment means. Applicants respectfully submit that neither Shavit nor

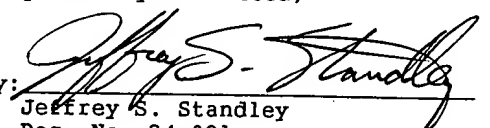
the Pronto system discloses a process that includes instructing a computer system to select particular payment means. Further, applicants find nothing in Shavit that contemplates payment by any non-electronic means.

Applicants respectfully submit that Shavit and the Pronto reference cited by the Examiner do not disclose in any way applicants' invention as presented in amended claims 1-16, 18-22 and 24-28. The present invention is new and unobvious with respect to the cited references in that none of them shows or suggests a bill-payment system including means for making payment to a payee independent of whether the payee or the consumer's financial institution has any relationship with the system, a method for paying a consumer's bills wherein the step of determining a preferred form of payment is performed by a computer system, or a process for enabling a service provider to make payments on a consumer's account that includes instructing a computer system to select particular payment means.

Applicant now believes this application to be in condition for allowance and earnestly requests such action.

Respectfully submitted,

Dated: April 2, 1993

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